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Eiji Hasegawa

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EXAMINER

TRUONG, THANHNGA B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/784,184	Applicant(s) HASEGAWA ET AL.	
	Examiner Thanhnga B. Truong	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed on May 19, 2008. Claims 1-17 are pending. At this time, claims 1-17 are still rejected.

Response to Arguments

2. Applicant's arguments with respect to claims 1-17 have been considered but they are not persuasive at least under **35 USC § 101**.

Applicant has argued that:

Claims 2-4 depend from independent claim 1, which is statutory subject matter.

Examiner respectfully disagrees with the applicant and still maintains that:

Even though claim 2 is depended on claim 1, its limitation alone shows the secure module is only judging whether or not an execution request signal for a divided program has been received, and returns the received program to the executable state when it is judged that the execution request signal has been received. Applicant uses language like "judging" a computer to do something. Recognize that all these claims require is that a reference does not prohibit a computer from doing the recited acts. They do not cause any functionality to occur in the computer. Thus, claim 2 recites non-statutory subject matter when it is standing by itself.

Claim 3 is depended on claim 2, thus it is rejected with the same rationale applied against claim 2 above.

Claims 6-8, 10, and 12 have limitations that are similar to those of claim 2, thus they are rejected with the same rationale applied against claim 2 above.

Applicant's arguments with respect to claims 1-17 have been considered but they are not persuasive at least under **35 USC § 102**.

Applicant has argued that:

Vos does not discuss or suggest these limitations:

a first storage unit; a processor for executing a program written in the first storage unit; a second storage unit for storing a plurality of **distinct** encrypted programs

into which a program is divided; and a secure module capable of performing operations of: receiving the program stored in the second storage unit; returning the received program to an executable state; writing the program, which has been returned to the executable state, in the first storage unit in a sequence for the processor to execute; and deleting the program, which has been executed by the processor, from the first storage unit after execution is completed, wherein the processor transmits the program stored in the second storage unit to the secure module, as recited in claim 1. The invention of claim 1 provides for dividing an encrypted program into a plurality of modules and decrypting only the module that is requested to be executed.

Examiner respectfully disagrees with the applicant and still maintains that:

Vos teaches the claimed subject matter, which has been addressed in the previous rejection and will be addressed again in this office action. In fact, Vos clearly teaches the secure module as shown in Figure 3 and more details in column 2, lines 15-64.

As for the newly language, "distinct" that has amended by the applicant to clarify "a plurality of **distinct** encrypted programs", it is unclear to the examiner how a plurality of encrypted programs are being called distinct. As a matter of fact, the term "distinct" does not even support anywhere in the specification, which could construed as new matter. Applicant needs to address or point out the meaningful area in the specification which support the phrase "a plurality of distinct encrypted programs", in order to avoid introducing a new subject matter. In addition, applicant has also mentioned that the invention of claim 1 provides for dividing an encrypted program into a plurality of modules and decrypting only the module that is requested to be executed, wherein the limitation of "decrypting only the module that is requested to be executed" does not even recite in claim 1.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., decrypting only the module that is requested to be executed) are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 5, 9, 11, 13, 15, and 17 recite the same subject matter as claim 1, thus they are rejected with the same rationale applied against claim 1 above.

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

For the above reasons, it is believed that the rejections should be sustained.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-4, 6-8, 10, and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. Referring to claim 2:

Claim 2 recites "wherein the secure module is further capable of judging whether or not an execution request signal for a divided program has been received, and returns the received program to the executable state when it is judged that the execution request signal has been received." The claim is clearly a software program and it is non-statutory as not being tangibly embodied in a manner so as to be executable. The secure module is possible for including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. Therefore, claim 2 recites a non-statutory subject matter.

Claim 3 is depended on claim 2, thus it is rejected with the same rationale applied against claim 2 above.

b. Referring to claims 6-8, 10, and 12:

i. These claims have limitations that are similar to those of claim 2, thus they are rejected with the same rationale applied against claim 2 above.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 5, 9, 11, 13, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims contain the term "distinct" to clarify "a plurality of distinct encrypted programs", it is unclear to the examiner how a plurality of encrypted programs are being called distinct. As a matter of fact, the term "distinct" does not even support anywhere in the specification, which could be construed as new matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Vos (US 4,849,927).

a. Referring to claim 1:

i. Vos teaches an information processing apparatus comprising:

(1) a first storage unit (**see Figure 3 of Vos**); a processor for executing a program written in the first storage unit (**see element 30 of Figure 3 of Vos**); a second storage unit for storing a plurality of distinct encrypted

programs (**e.g. new firmware program – column 5, lines 39-50 of Vos**) into which a program is divided (**see elements 38, 40 in Figure 3 of Vos**); and a secure module (**see Figure 3; more details in column 2, lines 15-64 of Vos**) capable of performing operations of: receiving the program stored in the second storage unit; returning the received program to an executable state; writing the program, which has been returned to the executable state, in the first storage unit in a sequence for the processor to execute; and deleting the program, which has been executed by the processor, from the first storage unit after execution is completed (**column 2, lines 15-64 of Vos**), wherein the processor transmits (**see element 35 in Figure 3 of Vos**) the program stored in the second storage unit to the secure module (**see Figure 3 of Vos**).

b. Referring to claims 2, 6:

i. Vos further teaches:

(1) wherein the secure module is further capable of judging whether or not an execution request signal for a divided program has been received, and returns the received program to the executable state when it is judged that the execution request signal has been received (**column 5, lines 30-55 of Vos**).

c. Referring to claims 3-4, 7-8, 10, 12, 14, and 16:

i. These claims have limitations that is similar to those of claim 2, thus they are rejected with the same rationale applied against claim 2 above.

d. Referring to claims 5, 9-17:

i. These claims have limitations that is similar to those of claim 1, thus they are rejected with the same rationale applied against claim 1 above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/
Primary Examiner, Art Unit 2135

TBT
September 15, 2008

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Art Unit: 2135

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